

REMARKS

Claim 1 is amended, and claim 4 is canceled herein; non-elected claims 9-16 were previously withdrawn from consideration. Claims 1-3 and 5-16 remain pending.

Support for amended claim 1 can be found, e.g., at originally filed claims 1 and 4.

The 35 U.S.C. § 102 Rejection of the Claims

Claims 1, 2, 4, and 6 were rejected under 35 U.S.C. § 102(b) as anticipated by Uke (U.S. Patent No. 5,303,917). This rejection is respectfully traversed.

Uke discloses a bat having a first hollow tubular member extending from the but end of the bat to form a handle (claim 1). The bat further contains a second hollow tubular member extending from the barrel end of the bat and having a hollow core (claim 1). The inner end of the first tubular member extends telescopically into the inner end of the second tubular member to form an overlapping region between the barrel and handle regions. The first member has a higher longitudinal flex modulus than the second member (claim 1). Uke discloses that the two members are of plastic material of different longitudinal and cross stiffness in the handle and barrel regions (column 1, lines 41-43). Uke discloses the fibers reinforcing the material in the handle are oriented mainly lengthwise with just a few angled or cross fibers to resist collapse, while the fibers reinforcing the barrel include a larger number of angle fibers (col. 1, lines 47-52). Uke discloses that the first tubular member (extending from the handle) may extend the entire length of the bat and be of reinforced plastic, while the second tubular member (extending from the barrel) is a protective sleeve of the same base plastic material without reinforcing fibers (emphasis added) (column 1, lines 56-59). Uke discloses that in another embodiment the tubular members overlap only in the transition region, so that the tubular members do not overlap in the barrel (column 2, lines 3-4).

The present invention concerns a bat having two discrete layers in the barrel of the bat — a hitting surface and a sleeve positioned within the hitting surface — where both layers are comprised of composite materials, and both are comprised of composite materials with resin and

reinforcing fibers to help launch the ball and prevent dents. Claims 1-8 recite that the hitting surface is made from a first set of fibers and a first resin and the sleeve is made from a second set of fibers and a second resin, the second set of fibers and second resin being different from the first set of fibers and the first resin. Uke does not disclose or suggest use of two layers in the barrel of the bat, where both layers are comprised of composite materials having fibers and a resin, and where the fibers and resin of the first layer differ from the fibers and resin of the second layer.

Uke discloses two tubular members, one fitting inside the other, and that the two tubular members may be made of composite materials. But Uke does not disclose that the resin of the two tubular members, if they are both made of composite materials, can be different in the two tubular members.

In one embodiment, Uke discloses the tubular members overlap only in the transition region. In this embodiment, then, there is not a sleeve position within the hitting surface, as recited in claims 1-8.

In the embodiment where the first tubular member extends the length of the bat, so there is a sleeve positioned within the hitting surface, Uke discloses that the outer tubular member is made of "the same base plastic material" as the inner tubular member, but is without reinforcing fibers (column 1, lines 56-59). Thus, where Uke discloses two layers in the barrel of the bat, it explicitly discloses they are made of the same resin. Furthermore, one layer does not have fibers at all. Thus, not only do the two layers not have different resins, they also do not have different fibers.

Nowhere does Uke disclose or suggest that the two tubular members be made of materials with different resins and different fibers, either when the inner tubular member extends to through the barrel of the bat, or even when it does not.

Since Uke does not disclose all the elements of claims 1-8, it does not anticipate claims 1-8. Accordingly, withdrawal of the rejection of claims 1-8 under 35 U.S.C. §102(b) as anticipated by Uke is respectfully requested.

The 35 U.S.C. § 103 Rejection of the Claims

Claims 3, 5, and 7 were rejected under 35 U.S.C. § 103(a) as obvious over Uke. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to modify the references or combine reference teachings so as to arrive at the claimed invention. Third, the art must provide a reasonable expectation of success. M.P.E.P. § 2143. The teaching or suggestion to arrive at the claimed invention and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure (M.P.E.P. § 2143, citing with favor *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Uke does not teach or suggest all the elements of claims 1-8. As discussed above, Uke does not teach or suggest a bat containing two layers---a hitting surface and a sleeve---each made of a set of fibers and a resin, where the set of fibers and the resin in the first layer are different from the set of fibers and the resin in the second layer.

Second, Uke does not contain a suggestion or motivation to modify its teachings to arrive at a bat where Uke's first tubular member would be made from a set of fibers and a resin and the second tubular member would be made from a different set of fibers and resin. First, Uke does not suggest using a different resin in the two tubular members. Second, Uke suggests that if the first tubular member extends through the barrel of the bat, so that there is a sleeve positioned within the hitting surface, the outer tubular member should not have fibers at all. Thus, one of skill in the art would conclude from reading Uke that if a bat is constructed with a sleeve within the hitting surface, the hitting surface should not be reinforced with fibers, because the sleeve provides adequate support. This teaches against the concept behind the presently claimed invention: two layers in the barrel of the bat — a hitting surface and a sleeve positioned within the hitting surface — where both layers are made of composite materials with resin and reinforcing fibers to help launch the ball and prevent dents (see page 7, lines 24-26 of the

specification), but where the two layers have different characteristics.

Much less does Uke teach or suggest the additional elements specifically recited in claims 3, 5, or 7. It does not teach or suggest a stiffness of the sleeve approximately 3 times the stiffness of the hitting surface. It does not teach or suggest a bat wherein the set of fibers of the hitting surface includes a tubular sock. It does not teach or suggest an E-glass fiber impregnated resin. Nor does it provide any suggestion or motivation to modify its teachings to arrive at a bat that includes these elements.

Since Uke does not establish two of the requirements for a *prima facie* case of obviousness, Applicant respectfully requests withdrawal of the rejection of claims 3, 5, and 7 under 35 U.S.C. § 103(a) over Uke.

Other References

Eggiman et al., Yeh, Seki et al., Baum, Souders et al., Philpot et al, Missono et al., and Feeney et al. were cited for interest by the Examiner. Applicant thanks the Examiner for his careful search.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-371-2111) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MATTHEW VACEK ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 371-2111

Date 2/19/2003 By Hugh McTavish
Hugh McTavish
Reg. No. 48,341

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 19 day of February, 2003.

Candis B. Buending
Name

Candis B. Buending
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